

### **Election/Restriction**

In accordance with the restriction and election requirement, Applicant provisionally elects, with traverse, Group II, corresponding to claims 13-23 and 58-63.

### **Remarks**

The office action required the following restriction under 35 U.S.C. §121:

I. Claims 1-12, drawn to a method of repairing a mutated exon of a pre mRNA in a mammalian cell comprising introducing a nucleotide sequence, classified in class 435, subclass 6.

II. Claims 13-23 and 58-63, drawn to DNA or probes that encode a repair RNA, classified in class 536, subclass 23.1.

III. Claims 24-34, drawn to a method of destroying a tumor cell comprising introducing a DNA that encodes an artificially shortened cell death pre-mRNA, classified in class 514, subclass 44.

IV. Claims 35-43, drawn to modified cell death RNA-encoding DNAs, classified in class 536, subclass 24.5.

V. Claims 44-57 and 64-65, drawn to methods and a kit for identifying potential splice sites of a cellular mRNA, classified in class 435, subclass 375.

The Office Action stated, with respect to each grouping, that there would be a serious burden on the Examiner if restriction was not required. Applicant respectfully disagrees that there would be a serious burden with respect to examining the claims together. Support for this assertion may be found, for example, in the International Search Report for the priority PCT application (PCT/EP2002/009082), wherein item 2, box II on page 4 was checked, stating "As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee." Further, related patent DE10139492B4 was also examined and issued without restriction.

Under 37 CFR §1.142, as interpreted in MPEP §803, “an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” As clarified in §803, There are **two** criteria for a proper requirement for restriction—“(A) The inventions must be independent or distinct as claimed, and (B) There would be a serious burden on the examiner if restriction is not required.” Applicant submits that the requirement in (B), at least, is not met, not only in light of a clear recognition of the potential for examination without restriction evidenced by the International Search Report and German applications, but also in light of the evident relationship of the claimed subject matter.

If, however, the Requirement is not withdrawn, Applicant wishes to preserve the ability to rejoin claims, as described in the Office Action, at the appropriate point during prosecution.

#### Conclusion

In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested.

If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$1,115 for a five month extension is believed to be due. However, please charge any other required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 7700-X04-013)

Respectfully submitted,

/ Paul D. Bianco /

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